

ELECTION

The Applicants respectfully elect with traverse the claims of Group IV, which according to the Patent Office, comprises claims 7-12, 54, 61-65 and 90. However, as set forth below, the Applicants respectfully submit that at least claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97 should be included in Group IV, which is drawn toward "an adjuster changed by environmental temperature". It is recognized that many of the above claims are generic and/or subgeneric, that is, generic to more than one Group but less than all Groups. Thus, upon a finding of allowability of any such generic or subgeneric claim, the remaining claims should be re-evaluated by the Patent Office to determine whether examination of such claims is appropriate.

ARGUMENT

The Applicants respectfully traverse the election requirement with respect to election of a single Group as defined by the Patent Office. The Patent Office has determined restriction to one of the following inventions is required:

- I. Claims 18-21, drawn to a head assembly increasing the gram load;
- II. Claim 29, drawn to head assembly with an arm beam;
- III. Claims 30-38, 69-72 and 91-92, drawn to a load beam having an adjuster;
- IV. Claims 7-12, 54, 61-65 and 90, drawn to an adjuster changed by environmental temperature;
- V. Claims 55 and 68, drawn to a head arm assembly having a modulus of elasticity;
- VI. Claims 56, 66 and 73, drawn to a head arm assembly made of different material;
- VII. Claims 60 and 86-89, drawn to drive circuitry of a disk drive; and
- VIII. Claims 74-85 and 93-97, drawn to a method of maintaining a slider.

With respect to Groups I – VII, the Patent Office states that these groups are "related as subcombinations disclosed as usable together in a single combination" pursuant to MPEP 806.05(d). Further, the Patent Office states that Groups I-VII and VIII "are related as product and process of use" pursuant to MPEP 806.05(h).

As set forth below, the Applicants respectfully submit that the restriction

requirement is improper and should be withdrawn.

First, the Applicants assert that the groupings of claims set forth by the Patent Office are believed to be inaccurate and incomplete. As one example, pending claims 22-28 and 46 are not included in any Groups established by the Patent Office. Further, the groupings appear to be arbitrary, as described below.

More specifically, many of the claims include specific limitations that would require that they be included in several of the Groups. In one example, the Patent Office lists that only claims 7-12, 54, 61-65 and 90 are "drawn to an adjuster changed by environmental temperature" (Group IV). More specifically, independent claim 54 includes the following language: "... the adjuster changing the gram load that is applied to the slider as the environmental temperature near the adjuster changes." Claim 61 includes the following language: "... the adjuster increases the gram load that is applied to the slider as the temperature near the adjuster decreases." Claim 90 includes the following language: "...a twenty °C decrease in temperature of the adjuster." According to the Patent Office, any of the above limitations would cause such claim to be categorized as one being drawn to "an adjuster changed by environmental temperature."

The Applicants submit that the limitations of the "environmental temperature near the adjuster", the "temperature near the adjuster" or the "temperature of the adjuster" are also positively recited in at least independent claim 18 ("temperature near the adjuster"), independent claim 30 ("temperature near the adjuster"), independent claim 55 ("environmental temperature near the adjuster"), independent claim 56 ("environmental temperature near the adjuster"), independent claim 60 ("temperature of the adjuster"), independent claim 74 ("temperature of the adjuster"), independent claim 86 ("environmental temperature near the adjuster") and independent claim 93 ("environmental temperature near the adjuster"). Further, the claims that depend from the foregoing independent claims include the limitations of their respective independent claims set forth above.

In summary, each of claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97 could be drawn to an adjuster changed by environmental temperature, which has been categorized by the Patent Office. As such, claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97 should be examined concurrently with the Group IV claims.

In another example, the Patent Office lists that only claims 18-21 are drawn to a head assembly that increases the gram load (Group I).¹ However, an adjuster that otherwise changes the gram load that is applied to the slider is positively recited in at least claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97.

In still another example, although the Patent Office lists that only claim 29 is drawn to a head assembly with an arm beam (Group II), the Applicants submit that an arm beam (as part of a head assembly) is also positively recited in at least claims 30-38, 71, 72, 84, 85, 91, 92, 96 and 97. Thus, according to the categorization devised by the Patent Office, claims 30-38, 71, 72, 84, 85, 91, 92, 96 and 97 should be listed as Group II claims.

In yet another example, the Patent Office lists that only claims 60 and 86-89 are drawn to drive circuitry of a disk drive (Group VII). However, drive circuitry is positively recited in at least claims 46, 60-66 and 68-97. Thus, according to the categorization of Groups by the Patent Office, claims 46, 60-66 and 68-97 should be listed as Group VII claims. Importantly, the foregoing examples are representative only, and are not intended to be exhaustive of all instances in which groupings appear to be problematic.

The MPEP also clearly states: "Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species." (MPEP §806.04(f); emphasis added). In other words, for a restriction between two species to be proper, the characteristics of one of the species can only exist to the exclusion of the other species. In the present case, the species set forth by the Examiner do not follow this requirement.

Based on the foregoing, the Applicants assert that the restriction requirement under MPEP 806.05(d) with respect to the Groups established by the Patent Office is improper, and should be withdrawn. Consequently, the claims of Species I-VIII, comprising claims 7-12, 18-38, 46, 54-56, 60-66 and 68-97, should be examined together as required by the

¹ Claims 18-21 collectively include language such as "increasing the gram load" and "decreases the gram load". Therefore, the Applicants understand the grouping by the Patent Office to include an adjuster that increases and/or decreases, e.g., *changes* the gram load that is applied to the slider.

Species designations of the Patent Office.

Alternatively, the Applicants respectfully submit that claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97 should be examined together as claims belonging to Group IV, which is drawn toward "an adjuster changed by environmental temperature".

Further, the Patent Office has also stated in its requirement for restriction that "the process for using the product as claimed can be practiced with another materially different product such as allowing for fluctuating flying height (i.e. CSS, disk topography, etc.)." The Applicants respectfully disagree with the rationale of the Patent Office. The Applicants submit that the Examiner has not provided any examples of "materially different products", but has instead provided different uses or applications for the product. In all examples, however, the "product" is still a disk drive, as claimed. Therefore, the restriction requirement based on MPEP 806.05(h) is believed to be improper, and should be withdrawn.

REMARKS

Claims 7-12, 18-38, 46, 54-56, 60-66 and 68-97 are pending in the above-captioned patent application following this amendment. Claims 7-12, 18-38, 46, 54-56, 60-66 and 68-97 are subject to a restriction requirement. The Group IV claims, comprising claims 7-12, 54, 61-65 and 90, were elected with traverse. However, the Applicants respectfully submit that at least claims 7-12, 18-28, 30-38, 46, 54-56, 60-66 and 68-97 should be included in Group IV, which is drawn toward "an adjuster changed by environmental temperature".

No new matter has been added by this amendment. Consideration of the Application is respectfully requested.

Interview Summary

On June 28, 2004, the undersigned attorney conducted a telephonic interview with Examiner David D. Davis. During the interview, the undersigned attorney explained why the established groupings were believed to be inappropriate. Further, the groupings of claims were discussed, as well as the inadvertent omission of claims 22-28 and 46 by the Patent Office from the restriction requirement. The Examiner agreed that the undersigned attorney should attempt to categorize the claims into one or more of the Groups established by the Patent Office, and explain the reasoning therefor. The undersigned attorney has included this analysis in the instant response. The Applicants and the undersigned attorney wish to thank the Examiner for his time and assistance during the interview.

Conclusion

In conclusion, the Applicants respectfully assert that all of the pending claims, including claims 7-12, 18-38, 46, 54-56, 60-66 and 68-97, should be examined together, and that the restriction requirement is improper and should be withdrawn. Alternatively, the Applicants submit that the Group IV claims, comprising claims 7-12, 54, 61-65 and 90, should be examined together with claims 18-28, 30-38, 46, 55-56, 60, 66, 68-89 and 91-97, which as set forth herein, are also believed to be Group IV claims drawn toward "an adjuster changed by environmental temperature." The pending claims are believed to be in condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-672-0454 for any reason that would advance the instant application to issue.

Dated this the 1st day of July, 2004.

Respectfully submitted,



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